

UNITED STATES DISTRICT COURT
DISTRICT OF OREGON
PORTLAND DIVISION

E.I. DU PONT DE NEMOURS AND)
COMPANY, a Delaware corporation) No. 03:12-cv-01104-HU
Plaintiff,)
VS.) **ORDER ON MOTION FOR DISCOVERY**
HERAEUS PRECIOUS METALS NORTH) **UNDER FED. R. CIV. P. 56(d)**
AMERICA CONSHOCKEN LLC, a) **AND ON THE DEFENDANTS' MOTION**
Delaware corporation; and) **FOR SUMMARY JUDGMENT**
SOLARWORLD INDUSTRIES AMERICA,)
INC., an Oregon corporation;)
Defendants.)

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HUBEL, Magistrate Judge:

The plaintiff E.I. Du Pont de Nemours and Company ("DuPont")
sues the defendants Heraeus Precious Metals North America Consho-
hocken LLC ("Heraeus") and SolarWorld Industries America, Inc.
("SolarWorld"), alleging infringement of DuPont's patent for a
conductive metallization paste used in the production of photo-
voltaic solar cells, U.S. Patent No. 8,158,504 ("the '504 Patent").
The defendants have moved for summary judgment of non-infringement,
as to both literal infringement and infringement under the doctrine
of equivalents ("DOE"). Dkt. #73.

Currently before the court is DuPont's motion pursuant to
Federal Rule of Civil Procedure 56(d), seeking additional discovery.
DuPont claims is "necessary to provide a complete record to the
Court for its ruling." Dkt. #86, p. 2. The defendants oppose the
motion, arguing no additional discovery is necessary for DuPont to
respond to their summary judgment motion, or for the court to rule
on the motion. The defendants claim DuPont has admitted it does
not have any claim for literal infringement, and no additional
discovery is necessary because the defendants' "summary judgment

1 motion turns on threshold legal questions" regarding applicability
2 of the DOE. Dkt. #94, ECF p. 2.

3
4 **STANDARDS**

5 Federal Rule of Civil Procedure 56(d) provides that when a
6 party "cannot present facts essential to justify its opposition" to
7 a summary judgment motion, the court may take one of three actions:
8 (1) "defer considering the motion or deny it; (2) allow time to
9 obtain affidavits or declarations or to take discovery; or (3)
10 issue any other appropriate order." To obtain the relief afforded
11 by Rule 56(d), a litigant, "'faced with a summary judgment motion,
12 shows the court by affidavit or declaration that "it cannot present
13 facts essential to justify its opposition.'" *Internat'l Longshore*
14 *& Warehouse Union v. Port of Portland*, slip op., 2013 WL 1412882,
15 at *10 (D. Or. Apr. 8, 2013) (Simon, J.) (quoting *Michelman v.*
16 *Lincoln Nat'l Life Ins. Co.*, 685 F.3d 887, 899 (9th Cir. 2012), in
17 turn quoting Fed. R. Civ. P. 56(d)). "A party requesting a
18 continuance pursuant to [former] Rule 56(f) [now 56(d)] must
19 identify by affidavit the specific facts that further discovery
20 would reveal, and explain why those facts would preclude summary
21 judgment." *Tatum v. City and County of San Francisco*, 441 F.3d
22 1090, 1100 (9th Cir. 2006) (citations omitted). "[A] district
23 court's order denying additional discovery [is reviewed] for abuse
24 of discretion." *Id.*

25 A district court does not abuse its discretion in denying a
26 request for additional discovery under Rule 56(d) if the party's
27 request is "vague and the discovery sought [does] not relate to the
28 legal issues presented on summary judgment." *Demaree v. Wal-Mart*

1 *Stores, Inc.*, slip op., 2013 WL 1037269, at *2 (9th Cir. Mar. 15,
2 2013).

3
4 ***DISCUSSION***

5 The defendants have moved for summary judgment that Heraeus's
6 "commercial front side photovoltaic paste products" do not infringe
7 any claim of the '504 Patent, either literally or under the DOE.
8 See Dkt. ## 73 & 74. DuPont's request for Rule 56(d) discovery
9 relates to its allegation that Heraeus's "commercial products"
10 infringe the '504 Patent under the DOE. An understanding of the
11 defendants' opposition to the requested discovery requires a brief
12 examination of the claims of the '504 Patent.

13 The '504 Patent was issued on April 17, 2012. See Dkt. #1-1.
14 The defendants describe the '504 Patent as follows:

15 The patent relates to thick film conductive
16 compositions that can be used to form
17 electrically conductive components of semi-
18 conductor devices, such as the metal contacts
19 on the front side (sun side) of a solar cell.
20 Such thick film pastes contain (1) conductive
21 metal powder (such as silver or aluminum), (2)
22 glass frit as an inorganic binder, and (3) an
23 organic medium. . . . A thick film paste can
be applied to a substrate, e.g., by screen-
printing, and then dried and fired to form
electrically conductive metal contacts that
form a pattern of conductor lines. . . . In a
solar cell, these metal conductor lines carry
the electrical current that is generated when
the silicon substrate is exposed to sunlight.

24 Dkt. #74, ECF pp. 6-7 (citations omitted).

25 The '504 Patent contains 12 claims. Claim 1 is an independent
26 claim upon which Claims 2 through 8 depend. Claim 9 is an indepen-
27 dent claim upon which Claim 10 depends. Claim 11 is an independent
28 claim upon which Claim 12 depends. See Dkt. #1-1, the '504 Patent,

pp. 22-23, cols. 30-32. The claims at issue in this case are the three independent claims: Claim 1, Claim 9, and Claim 11. See *Honeywell Int'l, Inc. v. Universal Avionics Sys. Corp.*, 488 F.3d 982, 995 (Fed. Cir. 2007) ("infringement of a dependent claim also entails infringement of its associated independent claim"); *Lyons v. Nike, Inc.*, 874 F. Supp. 2d 986, 1002 (D. Or. 2012) (Acosta, MJ) ("The law is clear that where an independent claim is not infringed, a dependent claim also is not infringed." Citation omitted.).

Claim 1 recites:

1. A thick film conductive composition comprising:
 - a) one or more electrically conductive powders;
 - b) one or more glass frits, wherein the T_g of the one or more glass frits is 300-600° C., as measured by Differential Thermal Analysis;
 - c) a ZnO additive; and
 - d) an organic medium, wherein the organic medium comprises ethyl cellulose and one or more components selected from the group consisting of: Bis(2-(2Butoxy-ethoxy)Ethyl)Adipate, dibasic ester, Octyl Epoxy Tallate, isotetradecanol, and pentaerythritol ester of hydrogenated rosin,
 wherein the ZnO additive is in addition to any ZnO present in the one or more glass frits.

Dkt. #1-1, p. 22, col. 30.

Claim 9 describes a method of manufacturing a particular semiconductor device that requires an organic medium identical to that described in Claim 1(d). *Id.*, p. 23, col. 31. Claim 11 also describes "[a] thick film conductive composition comprising . . . one or more electrically conductive silver powders"; one or more glass frits identical to those described in Claim 1(b); the same requirements as Claim 1 relating to the ZnO additive; and "an organic medium, wherein the organic medium comprises ethyl

1 cellulose and dibasic ester[.]” *Id.* (emphasis added). Thus, all
2 three independent claims require an organic medium consisting of
3 ethyl cellulose plus “one or more” additional components, but for
4 purposes of Claim 11, the additional component is specifically
5 identified as dibasic ester.

6 The listing of the “additional” ingredients of the organic
7 medium in Claims 1 and 9 is known as a Markush group.* “A Markush
8 group is a listing of specified alternatives of a group in a patent
9 claim, typically expressed in the form: a member selected from the
10 group consisting of A, B, and C. . . . It is well known that
11 members of the Markush group are . . . alternatively usable for the
12 purposes of the invention.” *Abbott Labs. v. Baxter Pharm. Prods.,*
13 *Inc.*, 334 F.3d 1274, 1280 (Fed. Cir. 2003) (internal quotation
14 marks, citation omitted); see *In re Driscoll*, 562 F.2d 1245, 1249
15 (Cust. & Pat. App. 1977) (“It is generally understood that in thus
16 describing a class of compounds an applicant is, in effect,
17 asserting that the members of the Markush group do not fall within
18 any recognized generic class, but are alternatively usable for the
19 purposes of the invention, and therefore, regardless of which of
20 the alternatives is substituted on the basic structure, the
21 compound as a whole will exhibit the disclosed utility.”).

22 The Federal Circuit has explained that a “Markush group,
23 incorporated in a claim, should be closed, i.e. it must be charac-
24 terized with the transition phrase “consisting of,” rather than

26 *Notably, there is no Markush “doctrine . . . but only a body
27 of case law, emanating from both ‘higher’ and ‘lower’ authority,
28 not altogether consistent, the latest decisions tending to carry
the most weight as precedent.” *In re Harnisch*, 631 F.3d 716, 720
(Cust. & Pat. App. 1980).

1 "comprising" or "including." *Id.* (internal quotation marks
2 omitted; citing Stephen A. Becker, *Patent Applications Handbook*
3 § 2:17 (9th ed. 2000); see *Gillette Co. v. Energizer Holdings,*
4 *Inc.*, 405 F.3d 1367, 1372 (Fed. Cir. 2005) ("A Markush group by its
5 nature is closed.") (citing *Abbott*, 334 F.3d at 1280). "The phrase
6 'consisting of' is a term of art in patent law signifying restric-
7 tion and exclusion, while, in contrast, the term 'comprising'
8 indicates an open-ended construction. . . . In simple terms, a
9 drafter uses the phrase 'consisting of' to mean 'I claim what
10 follows and nothing else.' A drafter uses the term 'comprising' to
11 mean 'I claim at least what follows and potentially more." *Vehicu-*
12 *lar Technologies Corp. v. Tital Wheel Int'l, Inc.*, 212 F.3d 1377,
13 1382-83 (Fed. Cir. 2000). In claiming a Markush group, the drafter
14 is effectively indicating that the members of the claimed group are
15 functionally equivalent. See *Gillette Co., supra*; cf. *Ecolochem,*
16 *Inc. v. So. Cal. Edison Co.*, 91 F.3d 169 (Table), 1996 WL 297601,
17 at *2 (Fed. Cir. June 5, 1996) ("By claiming a Markush group,
18 Ecolochem has indicated that, for the purpose of claim validity,
19 the members of the claimed group are functionally equivalent.").

20 The defendants ask the court to find that because the Markush
21 group in the '504 Patent does not specifically list Staybelite 3-E,
22 or any accused product, as an alternative "additional component,"
23 DuPont is foreclosed from arguing Staybelite, or any other compound
24 not listed in the Markush group, is an equivalent. Dkt. #94, ECF
25 p. 5. The defendants argue a finding that any of the accused
26 products is equivalent to any ingredient in the Markush group
27 "would vitiate the Markush Group limitation, which is by nature
28 restricted to the listed compounds." Dkt. #74, ECF p. 23; see

1 generally *id.*, ECF pp. 17-27. The defendants argue it is purely a
2 question of law for the court as to whether vitiation would apply
3 to foreclose DuPont's claim of infringement by equivalence, and
4 therefore, DuPont does not need any further discovery in order to
5 respond to the defendants' motion for summary judgment. Dkt. #94,
6 pp. 4-6.

7 The defendants' argument is overly simplistic, and ignores
8 recent Federal Circuit case law. In *Deere & Co. v. Bush Hog, LLC*,
9 703 F.3d 1349 (Fed. Cir. 2012), the court held as follows:

10 "Vitiation" is not an exception to the
11 doctrine of equivalents, but instead a legal
12 determination that "the evidence is such that
13 no reasonable jury could determine two ele-
14 ments to be equivalent." [*Warner-Jenkinson*
15 *Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39
16 n.8, 117 S. Ct. 1040, 1053 n.8, 137 L. Ed. 2d
17 146 (1997)]. The proper inquiry for the court
18 **is to apply the doctrine of equivalents**,
19 asking whether an asserted equivalent repre-
20 sents an "insubstantial difference" from the
21 claimed element, or "whether the substitute
22 element matches the function, way, and result
23 of the claimed element." *Id.* at 40, 117
24 S. Ct. [at 1054]. If no reasonable jury could
25 find equivalence, then the court must grant
26 summary judgment of no infringement under the
doctrine of equivalents. *Id.* at 39 n.8, 117
S. Ct. [at 1053 n.8].

20 Courts should be cautious not to short-
21 cut this inquiry by identifying a "binary"
22 choice in which an element is either present
23 or not present. Stated otherwise, the vitia-
24 tion test cannot be satisfied by simply noting
25 that an element is missing from the claimed
26 structure or process because the doctrine of
equivalents, by definition, recognizes that an
element is missing that must be supplied by
the equivalent substitute. If mere observa-
tion of a missing element could satisfy the
vitiation requirement, this "exception" would
swallow the rule.

27 *Deere*, 703 F.3d at 1356-57 (emphasis added); accord *Brilliant*
28 *Instruments, Inc. v. GuideTech, LLC*, 707 F.3d 1342, 1347 (Fed. Cir.

1 2013) (quoting *Deere*). The *Brilliant Instruments* court explained
2 further:

3 The vitiation test cannot be satisfied merely
4 by noting that the equivalent substitute is
5 outside the claimed limitation's literal
6 scope. Rather, vitiation applies when one of
7 skill in the art would understand that the
8 literal and substitute limitations are not
9 interchangeable, not insubstantially differ-
10 ent, and when they do not perform substantial-
11 ly the same function in substantially the same
12 way, to accomplish substantially the same
13 result. In short, saying that a claim element
14 would be vitiated is akin to saying that there
15 is no equivalent to the claim element in the
16 accused device based on the well-established
17 'function-way-result' or 'insubstantial dif-
18 ferences' tests.

19 *Brilliant Instruments*, 707 F.3d at 1347. These are factual issues
20 for determination by the jury. *Id.*

21 The cases cited by the defendants where courts have found
22 vitiation are both distinguishable on their facts, and overruled to
23 the extent they predated, and reached contrary results to, *Deere*
24 and *Brilliant Instruments*.

25 The court agrees with the defendants that no further discovery
26 is necessary for the court to rule on their motion for summary
27 judgment. It is apparent to the court from the record already
28 existing in this case that there are genuine factual issues as to
whether Heraeus's accused products infringe the '504 Patent under
the DOE. Accordingly, pursuant to the discretion afforded the
court under Rule 56(d)(1), the defendants' motion for summary
judgment (Dkt. #73) is **denied**, without prejudice to the reassertion
of their arguments, if appropriate, in any subsequent dispositive

1 motion filed pursuant to the case schedule to be determined in this
2 matter. As a result of this ruling, DuPont's motion for Rule 56(d)
3 discovery (Dkt. #86) is **moot**.

4 IT IS SO ORDERED.

5 Dated this 7th day of June, 2013.

6 /s/ Dennis J. Hubel

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8

Dennis James Hubel
Unites States Magistrate Judge